

REMARKS

I. Status of the Claims

Claims 1, 3-60 and 62-69 are pending in the application. Claims 20-22, 24, 30-39, 41, 58, and 67 are withdrawn from consideration. Claims 2 and 61 have been previously cancelled, and claim 64 has been cancelled herein. Claim 12 has been amended to remove the viscosity limitation. Claims 16 and 63 have been amended to address issues raised by the Office under 35 U.S.C. §112, second paragraph, by removing the phrases "chosen from polydimethylsiloxanes" and "in the form of a foundation, a blusher, and eyeshadow, an eyeliner, a mascara or a lipstick," respectively, and Applicants have accordingly added new claims 68 and 69, which are dependent on claims 16 and 63 respectively. No new matter has been introduced by these amendments, nor do the amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

Applicants gratefully acknowledge the withdrawal of the rejection of claims 1-4, 8, 10, and 11 under 35 U.S.C. §§ 102(b), and claims 1 and 3-11 under 35 U.S.C. § 112, second paragraph.

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The Office has rejected claims 16, 23, 44, 60, 63, and 64 under 35 U.S.C. § 112, second paragraph, as "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (July 3, 2003, Office

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Action, p. 2.) Applicants respectfully traverse this rejection at least for the reasons set forth below.

First, the Examiner has rejected claim 16 as indefinite because Applicant is “claiming a range within a range,” *i.e.*, polydimethylsiloxanes (PDMSs) and polymers. (*Id.*) Although Applicants do not agree that claim 16 was indefinite, solely in an effort to advance prosecution of this case, Applicants have amended claim 16, without prejudice or disclaimer, to remove the phrase “chosen from polydimethylsiloxanes (PDMSs),” and added a new claim dependant on claim 16. This rejection is thereby rendered moot. Accordingly, Applicants respectfully request withdrawal of this reason for rejection.

Second, the Examiner has rejected claim 63 as indefinite for also “claiming a range within a range,” *i.e.*, foundation, blusher, eye shadow, eyeliner, mascara, and lipstick and make-up. (*Id.*) Although Applicants do not agree that claim 63 was indefinite, solely in an effort to advance prosecution of this case, Applicants have amended claim 63, without prejudice or disclaimer, to remove the specific make-up products set forth in lines 3-4, and added a new claim dependent on claim 63. This rejection is thereby rendered moot. Accordingly, Applicants respectfully request withdrawal of this reason for rejection.

Third, the Examiner has rejected claim 23 as indefinite for use of the term “functionalized,” alleging that “one of ordinary skill in the art would not be apprised of its meaning.” (*Id.* at p. 3.) Applicants, however, believe that the term “functionalized” is well known in the chemical and cosmetic arts, and therefore, the ordinary skilled artisan would understand the scope of a claim using this term. For example, Nomenclature of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Organic Compounds states that the term is commonly used by organic chemists to denote groups of atoms that confer characteristic chemical properties upon the molecule in which it occurs. See Nomenclature of Organic Compounds 71 (John H. Fletcher et al. eds., American Chemical Society 1974) (attached). Accordingly, Applicants submit that the term "functionalized" does not render this claim indefinite, and therefore respectfully request withdrawal of this reason for rejection.

Fourth, the Examiner has rejected claims 44 and 60 as indefinite, alleging that the specification "does not explain the differences" in the terms "adjuvants and active principles" and "additives," and "one of ordinary skill in art would not be apprised of their different meanings." (*Id.*) Applicants, however, point out that the terms "adjuvants," "active principles," and "additives" are specifically described at pages 17, lines 8-13, and page 20, lines 3-8, of the as-filed application. Therefore, the ordinary skilled artisan, reading this disclosure, would understand the meaning of these various terms and thus the scope of the claims. Accordingly, Applicants respectfully request withdrawal of this rejection.

Finally, the Examiner has rejected claim 64 as indefinite because the term "thickened" is not defined by the claim nor does the specification provide a standard for ascertaining the requisite degree. Applicants have cancelled claim 64, thereby rendering this rejection moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

III. Rejections Under 35 U.S.C. § 103(a)

**A. European Patent No. 0 373 661 A2 in view of
U.S. Patent No. 6,074,633**

The Office has rejected claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, and 62-66 under 35 U.S.C. § 103(a) as obvious over European Patent No. 0 373 661 A2 ("EP '661") in view of U.S. Patent No. 6,074,633 ("633 patent"). (July 3, 2003, Office Action, pp. 3-6.) Applicants respectfully traverse this rejection for the reasons already of record and for those reasons stated below.

The Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alpha, omega-substituted oxyalklyenated silicone of the '633 patent with the oxyalklyenated silicone of EP '661," and one would be motivated to make this substitution because the '633 patent teaches that these silicones are interchangeable. (*Id.* at pp. 6, 9.)

In order to establish a *prima facie* case of obviousness, the Office must show that, *inter alia*, there is motivation to combine the references. M.P.E.P. § 2143. In the present case, Applicants maintain that there is no motivation to combine the references, and the express teachings of the references themselves would actually discourage the combination. EP '661 does not teach or suggest substituting the silicone disclosed therein with any α,ω -substituted oxyalklyenated silicone, let alone the specific ones of present claims 1 and 12. Both of the references describe difficulties with maintaining a stable emulsion; therefore, it would not have been obvious to substitute an element of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

one in the other, and one skilled in the art would certainly not have expected to be

successful in doing so in light of these teachings.

Furthermore, the use of a composition according to one reference would destroy the intended use of a composition according to the other reference, as the '633 patent is directed to a "detergent cosmetic composition" ('633 patent, claim 1) and EP '661 relates to a water-in-oil cosmetic composition (EP '661, p. 2, ln. 4). In other words, the '633 patent discloses a composition and process for "cleaning and/or washing the skin" by applying the compound disclosed and then rinsing it off with water (see Abstract), while EP '661 is directed to cosmetics, such as hand and face creams, lotions, and foundations, which are intended to remain on the skin (see examples), and in fact would be washed off by the composition of the '633 patent.

Therefore, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness of this combination, and accordingly, respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

B. U.S. Patent No. 6,159,486

The Office has rejected claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, and 62-66 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,159,486 ('486 patent"). (July 3, 2003, Office Action, pp. 6-9.) The Examiner alleges that the '486 patent exemplifies a water-in-oil emulsion comprising silicone oil and dyestuff and teaches α,ω -substituted oxyalkylenated silicones of the instant method as imparting stability to the emulsion, and therefore, one of skill in the art would be motivated to introduce into a composition an emulsion comprising α,ω -substituted oxyalkylenated silicones to reduce

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

transfer/migration of the composition. (*Id.* at pp. 7-8.) Applicants respectfully traverse this rejection for the reasons below.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, in the reference itself or in the knowledge of one of ordinary skill in the art, to modify the reference, and this suggestion cannot be found in the applicants' disclosure. M.P.E.P. § 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The mere fact that the prior art could be modified in a manner to yield the claimed invention does not make the modification obvious unless the prior art suggests the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Applicants point out that the stability of the prior art compound is imparted to the "water-in-oil emulsion" by the disclosed emulsifying surfactant, such as an α,ω -substituted oxyalkylenated silicone, and the reduction in transfer and/or migration of the prior art compound is due to the dispersion of a film-forming polymer. ('486 patent, col. 1, Ins. 45-60, col. 5, Ins. 50-56.) The reference does not teach or suggest that an α,ω -substituted oxyalkylenated silicone in an emulsion can reduce or eliminate migration or transfer of a product. Rather, the Examiner is engaging in impermissible hindsight in using the prior art to arrive at the present-invention.

The proper test for obviousness requires determining what the prior art would have led the skilled person to do. In the present case, the prior art does not teach or suggest that an α,ω -substituted oxyalkylenated silicone in an emulsion can reduce or eliminate migration or transfer of a product, nor has the Examiner pointed to any such

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

teaching or suggestion in the '486 patent as she must to satisfy her burden. Thus, as there is no motion to do so in the reference, only in hindsight after reviewing Applicants' disclosure could it have been obvious to one with the '486 patent before her to utilize an α,ω -substituted oxyalkylenated silicone in the claimed manner for reducing transfer/migration with any reasonable expectation of success.

Thus, as the Examiner has not pointed to any evidence of record that would lead one of ordinary skill in the art to have a reasonable expectation of success in obtaining the present invention, Applicants submit that the Examiner has failed to satisfy the burden of establishing a *prima facie* case of obviousness and respectfully requests that the § 103 rejection be withdrawn for at least this reason.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

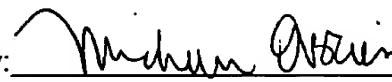
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

PATENT
Customer No. 22,852
Application No. 09/277,226
Attorney Docket No. 5725.0362-00

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 3, 2003

By: 
Michelle E. O'Brien
Reg. No. 46,203

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com